

Application No.: 10/020,592
Filing Date: December 12, 2001
Docket No: 760-46 CIP/PCT/USA/CON2
Page 6

REMARKS

The application has been amended. Claims 45 and 46 have been amended. Entry of this amendment and reconsideration of the application are respectfully requested.

Claims 36-40 remain withdrawn from consideration pursuant to 37 C.F.R. §1.142(b) as being drawn to a non-elected invention.

The Examiner has indicated that claims 25-35 are allowed and claims 43 and 44 contain allowable subject matter. This determination is gratefully acknowledged.

Claim 45 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. In view of the amendment to claim 45, this determination is respectfully traversed.

Claim 45 has been amended to obviate the Examiner's rejection. Accordingly, it is respectfully submitted that claim 45 and claim 46 which depends therefrom, are allowable.

Claims 41 and 42 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,762,128 to Rosenbluth. This determination is respectfully traversed.

The Rosenbluth reference shows a solid catheter shaft having an elongate annular depression formed at the distal end thereof. An inflatable balloon is positioned over the catheter shaft about the annular depression. The balloon conforms to the shape of the catheter shaft. A tubular stent is disposed within the annular depression formed by the catheter shaft and the overlying balloon. With the stent positioned within the depression, the end of the catheter provides a smooth generally uniform longitudinal profile which allows for introduction of the stent on the catheter without need for an overlying sheath.

In the present invention, as set forth in claim 41, a method of forming a stent delivery device is recited. A stent is placed on an inflatable portion of a catheter. The stent is releasably retained within depressions in the inflatable portion. Claim 41 specifically recites plural depressions which receive the stent. The arrangement between the depressions in the inflatable portion and the stent are clearly shown in Figures 6A and 6B of the present specification.

In Rosenbluth, a single annular depression is shown. The entire stent is retained in this single annular depression to enable the stent to be transported intraluminally. Rosenbluth fails to disclose plural depressions formed in an inflatable portion where the plural depressions releaseably retain the stent.

Application No.: 10/020,592
Filing Date: December 12, 2001
Docket No: 760-46 CIP/PCT/USA/CON2
Page 8

It is an axiom of patent law that for a reference to be anticipatory each and every element of the claim must be found in the reference, either expressly or inherently. In the present instance, the entire stent of Rosenbluth is supported in a single depression. In claim 41 the stent is releasably retained to the inflatable portion in plural depressions formed therein. As such, as a matter of law, Rosenbluth cannot be anticipatory of claim 41. Accordingly, it is respectfully submitted that claim 41 and claim 42 which depends therefrom are patentably distinct over Rosenbluth.

Having responded in full to the Office Action, it is respectfully submitted that the application, including claims 25-35 and 41-46 is in condition for allowance. Favorable action thereon is respectfully solicited.

Undersigned counsel wishes to again call to the attention of the Examiner the fact that the claims presently pending have been substantially copied from two issued U.S. patents, namely U.S. Patent No. 6,309,402 to Jendersee et al. and U.S. Patent No. 6,159,229 to Jendersee et al. (hereinafter the "Jendersee Patents"). Such information was provided to the Examiner in a communication filed on February 27, 2003.

Subsequently, in a personal interview conducted at the U.S. Patent and Trademark Office on June 15, 2004, the potential for interference with the Jendersee patents was discussed with

Application No.: 10/020,592
Filing Date: December 12, 2001
Docket No: 760-46 CIP/PCT/USA/CON2
Page 9

Examiners Corrine McDermott, Brad Pantuck and Justine Yu. In a record of the Interview Summary (copy attached) Examiner Pantuck acknowledged the potential for interference. The Examiner also agreed to "search the case and see if there is, indeed, interference". Applicants are still awaiting the Examiner's determination in this regard.

Applicants advise the Examiner that claims of the present application were copied or substantially copied from claims 1, 2, 4-6 and 8 of U.S. Patent No. 6,159,229 and claims 1, 2, 20, 21, 22, 24, 26, 27, 28, 30, 32, and 33-36 of U.S. Patent No. 6,309,402. Upon allowance of the subject matter in this application, Applicants will take the necessary steps under 37 C.F.R. §41.202 to suggest an interference if the Examiner agrees that there is interfering subject matter.

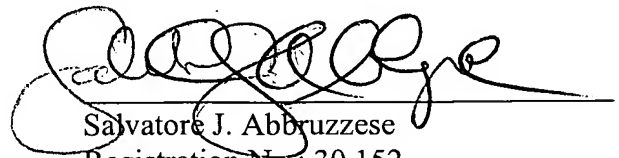
Reconsideration of the application and consideration of potential interference is respectfully requested.

The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 20-0776. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Application No.: 10/020,592
Filing Date: December 12, 2001
Docket No: 760-46 CIP/PCT/USA/CON2
Page 10

Should the Examiner have any questions or comments with regard to the application or this amendment, the Examiner is respectfully requested to contact undersigned counsel.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Salvatore J. Abbruzzese', written over a horizontal line.

Salvatore J. Abbruzzese
Registration No.: 30,152
Attorney for Applicant(s)

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700